

REMARKS

Claims 49, 51-53, 56-58, 61-63, 66-71, 73, 74; 76-78; and 80-83 were pending in this application.

Claims 51-52, 56, 58, 61-63, 66-68, 74, 76-78, and 80-82 have been canceled without prejudice. Applicants reserve the right to prosecute the subject matter of the canceled claims in one or more related continuation, continuation-in-part, or divisional applications.

Claims 53, 63, and 83 have been amended to revise the claim language as suggested by the Examiner. Claims 69, 70, 83 have been amended to delete dependencies from canceled claims.

No new matter has been introduced by this amendment. Claims 49, 53, 57, 69-70, 73, and 83 will be pending upon entry of the present amendment.

THE CLAIM OBJECTIONS SHOULD BE WITHDRAWN

Claims 51-52, 56, 61-63, 66-68, 76-78, and 80-82 have been objected to because they read on embodiments not included in the claim from which they depend. Without addressing the merits of this objection, Applicants have canceled these claims.

Thus, Applicants request that the objection to claims 51-52, 56, 61-63, 66-68, 76-78, and 80-82 should be withdrawn.

With regard to claims 53, 69, and 83, the Examiner suggested to replace the claim language "to go through only one round of replication" with the following language: "of going through only one round of replication." Applicants have amended the claims as suggested by the Examiner, and request that the objection to claims 53, 69, and 83 be withdrawn.

THE REJECTION UNDER 35 U.S.C. § 112 BASED ON LACK OF WRITTEN DESCRIPTION SHOULD BE WITHDRAWN

Claims 56, 61, 66, 70, 76, and 80¹ are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Without making any admissions as to the merits of the basis of this rejection, Applicants have canceled claims 56, 61, 66, 76, and 80.

Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

THE REJECTION UNDER 35 U.S.C. § 102 OVER MURPHY SHOULD BE WITHDRAWN

Claims 49, 51, 52, 56-58, 61-63, 66-68, 70, 73, 74, 76-78, and 80-82 have been rejected under 35 U.S.C. § 102(e) as anticipated by Murphy *et al.* (U.S. Patent No. 5,993,824; "Murphy"). In particular, the Examiner states that no support for a deletion of the NS1 gene could be found in Applicants' parent application serial number 08/316,439, filed September 30, 1994 (now U.S. Patent No. 5,840,520; "the '520 Patent"). Applicants disagree as set forth

¹ Applicants believe that claim 70 was listed in error because the Examiner states that these claims recite "one or more nucleotides." Claim 70, however, lacks such recitation. Accordingly, on the rejection of claims 56, 61, 66, 76, and 80 will be addressed.

in detail below. Because Applicants are entitled to their priority of September 30, 1994, Murphy, with its July 15, 1997 filing date, and priority dates of May 23, 1997, May 9, 1997, and July 15, 1996, is not prior art against the present application.

LEGAL STANDARD

It is well established that the law does not require that the specification provide support in exactly the same words as used in the claims to satisfy the written description requirement of 35 U.S.C. § 112, first paragraph. It is enough that the description conveys to one skilled in the art that the applicant had possession of the invention. For example, see *In re Wilder*, 736 F.2d 1516, 1520, 222 U.S.P.Q. 369, 372 (Fed. Cir. 1984):

It is not necessary that the claimed subject matter be described identically, but the disclosure originally filed must convey to those skilled in the art that applicant has invented the subject matter later claimed.

See also *Application of Lukach*, 442 F.2d 967, 969, 169 U.S.P.Q. 795, 796 (C.C.P.A. 1971): “[T]he invention claimed does not have to be described in *ipsis verbis* in order to satisfy the description requirement of § 112.”

THE '520 PATENT DISCLOSES NS1 DELETIONS

The disclosure of a vaccine or an immunogenic composition comprising an attenuated RSV with an NS1 deletion is found in the '520 Patent and entitled to a September 30, 1994 priority date. The invention disclosed in the '520 Patent includes deletions to the RSV genome in order to produce safe and efficacious vaccines (*see, e.g.*, column 44, lines 24-32). The '520 Patent provides by way of example that modifications may be made to influenza, including deletions to the NS1 and NS2 coding sequences (*see, e.g.*, column 6, lines 51-53). In particular, the '520 patent provides that the principles that are described and illustrated for influenza virus can analogously be applied to other viruses, such as RSV (*see*, column 14, lines 46-55 of the '520 Patent). Thus, the teaching that a virus can be constructed with an NS1 deletion is applicable to RSV.

Taken together, the '520 Patent describes RSV vaccines having deletions to the NS1 coding region.

Thus, Applicants are entitled to a priority date that predates Murphy. Accordingly, Murphy is not prior art and the rejection under 35 U.S.C. § 102(e) over Murphy should be withdrawn.

The Rejection Under 35 U.S.C. § 103 Over Murphy Should Be Withdrawn

Claims 49, 51-53, 56-58, 61-63, 66-71, 73, 74, 76-78, and 80-83 are rejected under 35 U.S.C. § 103 over Murphy in view of Knipe et al. (U.S. Patent 7,223,411; "Knipe") and Inglis et al. (U.S. Patent 5,665,362; "Inglis"). As discussed above, Murphy is not prior art against the presently pending claims. Neither Knipe or Inglis teaches or suggests recombinant RSV with a genetic alteration.

Thus, the rejection of claims 49, 51-53, 56-58, 61-63, 66-71, 73, 74, 76-78, and 80-83 under 35 U.S.C. § 103 over Murphy in view of Knipe and Inglis should be withdrawn.

Provisional Double Patenting

Claim 49 has been provisionally rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as claim 24 of U.S. Patent Application Nos.: 11/690,957. As this rejection is a provisional rejection, Applicants will not address this rejection at this time.

The Examiner stated that claims 57 and 61-63 of the instant application are substantially identical to claims 58 and 66-68. Without addressing the Examiner's statement on the merits, Applicants point out that claims 58, 61-63, and 66-68 have been canceled without prejudice.

The Examiner stated that claim 53 is substantially identical to claim 71. Without addressing the Examiner's statement on the merits, Applicants point out that claim 71 has been canceled without prejudice.

The Examiner stated that claims 49, 57, 58, 73, and/or 74 are substantially identical to claims 53, 61, 66, 76, and/or 80. Without addressing the Examiner's statement on the merits, Applicants point out that claims 61, 66, 76, and 80 have been canceled without prejudice. It is further noted that dependent claim 53 adds the limitation that the virus is capable of going through only one round of replication. None of the independent claims 49, 57, 73, and/or 74 is so limited. Thus, claim 53 is not substantially identical to any one of claims 49, 57, 73, and/or 74.

Claims 51, 52, 56, 57, 58, 61-63, 66-68, 70, 73, 74, 76-78, and 80-82 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 17, 24, 29, 31, 32, and 35 of U.S. Application Serial No. 11/690,957. As this rejection is a provisional rejection, Applicants will not address this rejection at this time.

Claims 53, 69, 71, and 83 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 17, 24, 29, 31, 32, and 35 of U.S. Application Serial No. 11/690,957 in view of Murphy, Knipe, and Inglis. As this rejection is a provisional rejection, Applicants will not address this rejection at this time.

CONCLUSION

Applicants respectfully request entry and consideration of the foregoing amendments and remarks. No new matter has been introduced. The claims are believed to be free of the art and patentable. Withdrawal of all the rejections and an allowance are earnestly sought. Please charge any additional fee that may be required in connection with this filing to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

Date: March 19, 2008

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